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OFFICE OF PETITIONS

In re Patent of Buhr et al.	:	
Patent No. 5,672,697	:	
Issue Date: September 30, 1997	:	Letter
Application No. 07/652,978	:	
Filing Date: February 8, 1991	:	
Attorney Docket No. GLIS-0064	:	

Request for Information

This is a response to the "Petition for Reconsideration Under 37 C.F.R. § 1.378(e)" filed December 4, 2007.

The Office requests petitioner supply additional information concerning the delay in the submission of maintenance fees in this case.

Petitioner should submit the requested information within **TWO MONTHS** of the mailing date of this letter. Extensions of time may not be obtained. No additional fee is due for a response to the instant request for information. The response to this Requirement for Information should include a cover letter entitled "Response to Request for Information." *The failure to file a reply to the instant Request for Information will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter.*

Any response to the instant Request for Information should be filed electronically using the Office's Electronic Filing System (EFS-Web).

Procedural Background

Application No. 07/652,978 was filed February 8, 1991. The application issued as Patent No. 5,672,697 on September 30, 1997.

An application for reissue of the instant patent was filed September 29, 1999. The reissue application was assigned Application No. 09/408,396.

The 3.5 year maintenance fee for the instant patent could have been paid from September 30, 2000, to March 30, 2001, or with a surcharge from March 31, 2001, to Monday, October 1, 2001. The fee was not timely paid. As a result, the patent expired on October 1, 2001.

An Order to Show Cause was mailed in Application No. 09/408,396 on May 16, 2006. The order indicated Patent No. 5,672,697 had expired due to non-receipt of the 3.5 year maintenance fee. The order also indicated the 7.5 year maintenance fee had not been paid for the patent.

A "Response to Order to Show Cause and Petition for Delayed Payment of Maintenance Fees Pursuant to 37 CFR § 1.378(b)" ("Response") was filed in Application No. 09/408,396 on June 6, 2006.

A Second Order to Show Cause was mailed in Application No. 09/408,396 on November 13, 2006. The Second Order to Show Cause did not directly address the merits of the petition under 37 C.F.R. § 1.378(b) filed as part of the response.

A petition under 37 C.F.R. § 1.378(b) directed to the instant patent, not the reissue application, was filed December 11, 2006. The petition was accompanied by payment of \$4,860 for the following fees:

- (1) \$900 for the 3.5 year maintenance fee,
- (2) \$130 for the grace period fee set forth in 37 C.F.R. § 1.20(h) for the 3.5 year maintenance fee,
- (3) \$2,300 for the 7.5 year maintenance fee,
- (4) \$130 for the grace period fee set forth in 37 C.F.R. § 1.20(h) for the 7.5 year maintenance fee, and
- (5) \$700 for the surcharge set forth in 37 C.F.R. § 1.20(i).

The December 11, 2006 petition stated,

ISIS Pharmaceuticals, Inc. acquired a portfolio of patents and patent applications including the [instant] patent in 1998. Since that time, ISIS has used a computerized docketing system to monitor due dates and other activities related to the portfolio....

[T]he paralegal who entered ... information into the database after ISIS acquired the patent mistakenly identified its status as "inactive." That this error was simply one of data entry is indicated by the fact that other patents in the acquired portfolio are not identified in the database as "inactive." Because the docketing system understood the [instant] patent to be inactive, none of the prompts or reports that the system subsequently generated concerning the acquired portfolio identified maintenance fees that were due in connection with the patent. Although the paralegal appears to have received a notice of patent expiration in the March, 2002, timeframe, no such notice can be found in Applicants' files, nor is the undersigned or anyone currently employed in ISIS' patent department aware of ever having seen it.

On May 4, 2007, the Office mailed a decision dismissing the petition. The decision stated,

[S]ince this case involves importation of a patent from a previous owner[,] the routine for such transfer should be explained. If there occurred in this instance one or more clerical errors, petitioner should supply information regarding the training provided to the [person who made the error], degree of supervision of their work, examples of other work

functions carried out and checks on the described work which were used to assure proper execution of assigned tasks. An adequate showing requires where possible statements by all persons with direct knowledge of the circumstances surrounding the delay....

As noted above, statements from all persons who have firsthand knowledge of the circumstances which caused or contributed to the delay are required.

A "Petition for Reconsideration Under 37 C.F.R. § 1.378(e)" was filed December 4, 2007. The request includes a declaration by Herb Boswell, an Executive Director in the patent department of ISIS.

Facts

ISIS hired Jill Kathleen Joe as a Patent Docketing Coordinator in March 1998. At the time she was hired, Ms. Joe had a total of approximately nine years of experience working in various positions at different law firms.

ISIS began using a PCMaster computer database program during mid-1998.

"During [Ms Joe's] employment at ISIS, Ms. Joe had various file clerk assistants who reported to her; however, from Ms. Joe's hire date until at least 2002, she opened the majority of new file records in the database."¹

During 1998, ISIS acquired a portfolio including the instant patent and several other patents and patent applications.

The PCMaster record for the instant patent was created on February 12, 1999. Boswell asserts the database record "appears" to have been created by Ms. Joe.

The PCMaster record for Reissue Application No. 09/408,396 was created on November 3, 1999. Boswell asserts the record "appears" to have been created by Ms. Joe.

Boswell asserts the status for the instant patent was either listed as inactive in PCMaster when the record for the instant patent was created on February 12, 1999, or changed to inactive when the record for the reissue application was created on November 13, 1999.

Exhibit B for the Boswell declaration includes a screenshot showing information in the PCMaster database for the instant patent.

1. The "Comment" section states, "SEE GLIS-0128 for REISSUE."
2. The "Status" section states, "INACTIVE."
3. The "Sub Status" section states, "Surrendered (Reissue)."
4. The "Sub Status Date" section states, "9/29/1999."

¹ Boswell Declaration, ¶ 5.

The screenshot indicates the record for the instant patent was last updated on April 10, 2002, by “CRGW.” The screenshot fails to identify the specific changes made by CRGW.

Boswell’s declaration states various factors have led him to conclude the error in the docketing system “was simply one of data entry.”²

Boswell asserts Ms. Joe had considerable experience involving patents and was experienced at using the PCMaster program as of the date the error was made.

Boswell states,

While employed by ISIS[,] Ms. Joe opened hundreds (and perhaps even thousands) of records in the ISIS patent database.... To [the best of] my knowledge, this instance relating to the [instant patent] is the first time that a due date has been missed due to incorrect data entry for any of the several thousand records that currently are in ISIS’ PCMaster database.³

Boswell states,

The “Status” code in the PCMaster database is entered by selecting one of four choices from a “dropdown menu” or by entering a shorthand code. The shorthand codes and choices are: D and DOCKETED, F and FILED, G and GRANTED, and I and INACTIVE.... [On the dropdown menu,] the “INACTIVE” choice is adjacent to and immediately below the “GRANTED” choice, thus increasing the likelihood of making a mistaken selection amount them.⁴

Boswell asserts none of the other patents ISIS has surrendered for reissue in the past are identified in the database as inactive.

Information Requested

The record fails to clearly identify the individual who created the database record for the instant patent on February 12, 1999. Although Boswell’s declaration states Ms. Joe “appears” to have been the individual who created the record, such a statement is not the equivalent of a statement asserting Ms. Joe was the individual who created the record. The Office acknowledges Boswell’s assertion Ms. Joe opened the majority of file records during her employment with ISIS. However, the fact she opened the majority of file records is not proof she was the individual who created the record on February 12, 1999.

² Id. at ¶ 10.

³ Id. at ¶ 11.

⁴ Id. at ¶ 8.

If petitioner is completely certain Ms. Joe is the individual who created the record for the instant patent, any response to the instant request should *fully* discuss the basis for such certainty.

If petitioner is not completely certain Ms. Joe is the individual who created the record on February 12, 1999, any response to the instant request should identify all the other individuals who may have created the record. The response should discuss, for each of the other individuals, the training the individual received, the degree of supervision of the individual's work, examples of other work functions carried out by the employee, and checks on the employee's work which were used to assure proper execution of assigned tasks.

The record fails to clearly identify the individual who made changes to the record for the instant patent on November 13, 1999. Although Boswell's declaration states Ms. Joe "appears" to have been the individual who made the changes, such a statement is not the equivalent of a statement asserting Ms. Joe was the individual who made the changes.

If petitioner is completely certain Ms. Joe is the individual who made changes to the record on November 13, 1999, any response to the instant request should *fully* discuss the basis for such certainty.

If petitioner is not completely certain Ms. Joe is the individual who made changes to the record on November 13, 1999, the response to the instant request should identify all the other individuals who may have created the record. The response should discuss, for each of the other individuals, the training the individual received, the degree of supervision of the individual's work, examples of other work functions carried out by the employee, and checks on the employee's work which were used to assure proper execution of assigned tasks.

Any response to the instant request for information should fully discuss the extent to which the law firm was, or was not, reasonable in relying on the individual who may be asserted to have made a mistake in a reissue application prior to November 13, 1999. For example, the discussion should indicate whether or not the individual who made the mistake had ever been informed maintenance fees must continue to be paid for a patent, *even if the patent has been surrendered*, up until the date a reissue patent is granted. If the identity of the individual who made the mistake is uncertain, the response should set forth the reissue training received by each of the employees who might have made the mistake.

The petition does not identify the exact changes made to the record for the instant patent on November 13, 1999. What changes were made on November 13, 1999? Was the "Comment" section changed to state, "SEE GLIS-0128 for REISSUE," on November 13, 1999? Was the "Sub Status" section changed to state, "Surrendered (Reissue)," on November 13, 1999? Was the "Sub Status Date" section changed to state, "9/29/1999," on November 13, 1999?

The screenshot of the record for the instant patent indicates the record was last updated on April 10, 2002, by "CRGW." Who is CRGW? What information, if any, did CRGW add to the record? What information, if any, did CRGW delete from the record? What information, if any, did CRGW change?

When evaluating the reliability of an individual's work, one may reasonably consider whether or not the employee has made similar errors when handling other cases. In this case, Boswell asserts a factor supporting his belief the error was simply a data entry error is the fact none of the other patents that ISIS has surrendered for reissue are identified in the database as inactive.

Any response to the instant request for information should explicitly identify *all* the reissue applications filed by ISIS starting from the date ISIS first implemented PCMaster and ending on January 1, 2005. For each reissue application, petitioner should,

- (1) Identify the date the reissue application was filed,
- (2) Identify the original patent by patent number,
- (3) Identify the approximate date, or exact date if possible, changes were made to the record for the original patent as a result of the filing of the reissue application,
- (4) Identify all changes made to the record for the original patent when the reissue application was filed, and
- (5) Identify the individual who made the changes.

As stated in the decision mailed by the Office on May 4, 2007, a petition under 37 C.F.R. § 1.378(b) should be accompanied by "statements from all persons who have firsthand knowledge of the circumstances which caused or contributed to the delay." The instant renewed petition does not include a statement from Ms. Joe or any other employee who may have created or changed the record for the patent. If petitioner is certain Ms. Joe created the record and made the changes to the record on November 13, 1999, a statement from Ms. Joe should be filed. If one or more other individuals may have created the record and/or made the changes to the record on November 13, 1999, then a statement from each such individual should be supplied. If a statement from Ms. Joe or any other individual who may have created the record and/or changed the record on November 13, 1999, cannot be obtained, petitioner should fully discuss all reasons ISIS was unable to obtain the statement(s).

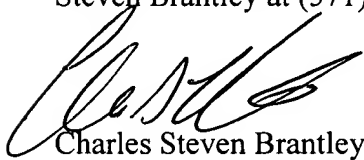
Fees

Payment of the 11.5 year maintenance fee is now necessary in order for the Office to reinstate the patent. Therefore, any response to the instant request for information should include payment of \$4,110 for the 11.5 year maintenance fee.

Petitioner has submitted the \$130 surcharge set forth in 37 C.F.R. § 1.20(h) for the 3.5 year maintenance fee. Petitioner has also submitted the \$130 surcharge set forth in 37 C.F.R. § 1.20(h) for the 7.5 year maintenance fee. The only surcharge necessary when filing a petition under 37 C.F.R. § 1.378(b) is the \$700 surcharge set forth in 37 C.F.R. § 1.20(i). Therefore, the Office has credited \$260 to Deposit Account No. 23-3050.

Petitioner submitted a \$700 surcharge for the 3.5 year maintenance fee and a \$700 surcharge for the 7.5 year maintenance fee. The \$700 surcharge only needs to be paid a single time when filing a petition under 37 C.F.R. § 1.378(b) even if more than one maintenance fee was not timely paid. Therefore, \$700 has been credited to Deposit Account No. 23-3050.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'C. S. Brantley', written in a cursive style.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions